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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,959	09/17/1999	KARL ERIK STAHL	927.1003	9455

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EXAMINER

DUONG, DUC T

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

58

Office Action Summary	Application No.	Applicant(s)	
	09/397,959	STAHL, KARL ERIK	
	Examiner	Art Unit	
	Duc T. Duong	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☒ Claim(s) 9, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 5-7, filed December 21, 2005, with respect to the rejection(s) of claim(s) 1-12 under 35 USC 102 (e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Mortsof et al (US Patent 6,229,804 B1).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 2, and 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Mortsof et al (US Patent 6,229,804 B1).

Regarding to claims 1 and 4, Mortsof discloses a telecommunication apparatus 23 for initiating and receiving voice and data calls (fig. 2) comprising a first port

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(connection from the gateway 23 to the terminal 24) to connect said apparatus 23 to a PSTN network 14' (col. 2 lines 23-28), a second port (connection from the gateway 23 to the Internet 18) to connect said apparatus to a packet-based network 18 (col. 2 lines 23-28), and a gateway means (implicitly shown) for establishing a path (call from terminal 10 to terminal 24) between said first port and said second port inside said apparatus in response to a request from a gatekeeper 20 on the Internet 18 acting on behalf a caller 10 (col. 3 lines 23-31), whereby said telecommunication apparatus 23 can serve as part of a distributed gateway system (a distributed gateway system is defined in the specification on page 18, lines 5-7 as a gateway connecting to both the PBDN and the PSTN) between said circuit switched telecommunication network 18 and said packet based telecommunication network 14 (fig. 2; the gateway 23 serve as a distributed gateway system connecting to both the PSTN 14 and the Internet 18).

Regarding to claim 2, Mortsof discloses a third port (connection from the gateway 23 to the terminal 22) to connect a conventional telephone apparatus 22 via said telecommunication apparatus 23 to said first port (fig. 2 col. 2 lines 23-28).

Regarding to claim 5, Mortsof discloses gateway location servers 20 connected to said Internet 18, said gateway location servers 20 being adapted to receive a request from a first telecommunication apparatus 16 connected to said Internet 18 for telecommunication with a specified telephone apparatus 22/24 on said PSTN network 14, and further being programmed to select a second of said telecommunication apparatuses 23 to serve as gateway between said networks for said requested

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connection, and to forward to said request to said second telecommunication apparatus 23 via Internet 18 (fig. 2 col. 3 lines 11-31).

Regarding to claims 6 and 7, Mortself discloses the packet based telecommunication network comprises the Internet 18 (fig. 2 col. 2 lines 15-17).

Regarding to claim 8, Mortself discloses a telecommunication apparatus 23 for initiating and receiving voice and data calls (fig. 2) comprising a first port 242 (connection from the gateway 23 to the terminal 24) to connect said apparatus 23 to a PSTN network 14 (col. 2 lines 23-28), a second port (connection from the gateway 23 to the Internet 18) to connect said apparatus 23 to the Internet 18 (col. 2 lines 23-28), and a gateway means (implicitly shown) for establishing a path (call from terminal 10 to terminal 24) between said first port and said second port inside said apparatus in response to a request from the Internet 18 (col. 3 lines 23-31); and gateway location servers 20 connected to said Internet 18, said gateway location servers 20 being adapted to receive a request from a first telecommunication apparatus 16 connected to said Internet 18 for telecommunication with a specified telephone apparatus 24 on said PSTN network 14, and further being programmed to select a second of said telecommunication apparatuses 23 to serve as gateway between said networks for said requested connection, and to forward to said request to said second telecommunication apparatus 23 via Internet 18 (col. 3 lines 11-31), whereby said telecommunication apparatus 23 can serve as part of a distributed gateway system (a distributed gateway system is defined in the specification on page 18, lines 5-7 as a gateway connecting to both the PBDN and the PSTN) between said circuit switched telecommunication

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network 18 and said packet based telecommunication network 14 (fig. 2; the gateway 23 serve as a distributed gateway system connecting to both the PSTN 14 and Internet 18).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mortsof in view of Chan et al (U.S. Patent 6,711,160 B2).

Regarding to claim 3, Mortsof discloses all the limitations with respect to claim 2, except for a mechanism to automatically connect said third port directly to said first port in the event of power failure. However, Chan discloses packet telephone system comprising a fallback switch 110 for connecting a telephone handset 111 (third port) directly to a PSTN interface 112 (first port) in the event of power failure (fig. 1 col. 6 lines 51-64). Thus, it would have been obvious to a person of ordinary skill in the art to employ a fallback switch as taught by Chan in Mortsof's system to provide an optional arrangement capable of making telephony connection when the packet network is inactive.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mortsof in view of Bhattacharya et al (US Patent 6,353,610 B1).

Regarding to claim 10, Smith discloses all the limitations with respect to claim 9, except for a means for automatically notifying said gateway location servers when its PSTN connection is Off Hook so it temporarily is not available to serve as a gateway between the packet based network and the circuit switched network. However, Bhattacharya discloses an internet telephony system, wherein a source gateway 100 (gateway location server) is notified of an off hook condition when the destination gateway 130 serving between the Internet 125 and the PSTN 145 detects a busy signal (fig. 1 col. 4 lines 52-61). Thus, it would have been obvious to a person of ordinary skill in the art to employ an off hook notification as taught by Bhattacharya in Mortsof's system to alert the subscriber of the connection status.

Allowable Subject Matter

7. Claims 9, 11, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Duong whose telephone number is 571-272-3122. The examiner can normally be reached on M-F (9:00 AM-6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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RICKY Q. NGO
SUPERVISORY PATENT EXAMINER